

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. CRUZ

Appeal No. 2003-0656
Application No. 29/124,773

ON BRIEF

Before COHEN, FLEMING and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of the following design claim:

The ornamental design for "ATHLETIC SHORTS" as shown and described.

The design is depicted in a front elevation view, a right side elevation view, front top right side perspective view and a bottom front left side perspective view in the application drawing Figures 1 through 4, respectively.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hong Kong Apparel, Vol. II (1996), copy in design library, p. 203, Metimex S.A. (Metimex).

Sportpages Catalog, item 18 F (Summer, 1980), copy in design library, p. 18 (Sportpages).

The appealed design claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Metimex in view of Sportpages. We reverse for the reasons that follow.

OPINION

Upon careful review of the respective positions advanced by appellant and the examiner with respect to the rejection that is before us for review, we find ourselves in agreement with appellant's viewpoint in that the examiner has failed to carry the burden of establishing a prima facie case of obviousness. Accordingly, we will not sustain the examiner's rejection.

"In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration." In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). "In ornamental design cases, a proper obviousness rejection based on a combination of references requires that the visual ornamental features (design characteristics) of the claimed design appear in the prior art in

a manner which suggests such features as used in the claimed design." In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993) (citing In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663 (Fed. Cir. 1987); In re Carlson, 983 F.2d 1032, 1038, 25 USPQ2d 1207, 1212 (Fed. Cir. 1992). "If, however, the combined teachings suggest only components of a claimed design, but not its overall appearance, an obviousness rejection is inappropriate." Id.

Here, we agree with appellant's position since the examiner has not established that the overall visual impression of the claimed athletic shorts design would have been suggested by the applied prior art to a designer of ordinary skill in the art.

In fashioning the rejection before us for review, the examiner uses Metimex as a basic reference; that is, as a Rosen-type reference and employs Sportpages to suggest modifications of Metimex that, according to the examiner, would have been obvious to a designer of ordinary skill in the art. The shorts design depicted in Metimex, like appellant's claimed design, portrays a visible elastic waste band and elongated side areas or panels running from the waste band to essentially the bottom of the outside of each leg with those side areas/panels possessing an outer surface area appearance that is visually distinct from the

appearance of the outer surface area of the main portion of the shorts.

Appellant does not specifically contend in the brief that the shorts design depicted in Metimex would not represent a Rosen-type reference. However, appellant argues that the claimed design is not suggested by Metimex taken in combination with Sportpages for several reasons as set forth in the brief.

Among the argued visually distinctive features of the claimed design, appellant notes the differences in the appearance of the side panels of the claimed design over the side panels of Metimex. Appellant argues that the appearance of the sides of appellant's shorts is highlighted by the coarse or rough lines depicted in the figures, which can be seen as extending to at least a portion of the visible inside surface of the legs of the fabric as shown in appellant's drawing figure 4 in comparison to the smoother surface markings on the rest of the shorts design observable in the drawings. Here, we share the view of appellant that the visual impression of the two contrasting looks for the side and the rest of the shorts as depicted in appellant's drawing figures give an overall visually distinct impression from that which would have been readily seen or suggested to a

designer of ordinary skill in the art from Metimex taken with Sportpages.

While we agree with the examiner that the identity of a specific material is not part of the claimed design, the visual impact of the materials used is clearly a portion of appellant's overall design. The Metimex shorts design is characterized by the appearance of white lines and patches at the sides thereof, which patches do not extend to the inside surface of the leg openings of the shorts design. Consequently, the Metimex shorts design yields an overall distinct appearance as to the relative roughness and consistency of the surface appearance of the sides as well as the lack of an extension thereof to the inside of the leg openings as compared to the claimed design as clearly shown by a comparison of the Metimex shorts design with appellant's drawing figures, particularly figure 4.

Moreover, even if it would have been obvious to a designer of ordinary skill in the art to modify the Metimex shorts by incorporating the design features of the sides of the shorts of the Sportpages shorts therein as contended by the examiner (answer, page 3), such a modification would not result in the claimed design but rather a design wherein the sides of the shorts of Metimex includes the look of a finer finish rather than

a coarse appearance as depicted in appellant's design. This is so since the shorts shown in Sportpages suggests a fashion look wherein the main shorts material has a coarse surface view and the sides give the impression of a smoother appearance. That, of course, would yield an opposite position for those relatively rough and smooth surface ornamentations and a readily discernible difference in visual impression than that given by the claimed design.

In addition, the examiner has not fairly established that the shorts of Sportpages would have plainly suggested to a designer of ordinary skill in the art an extension of the side patch to the underside of the leg openings of the shorts of Metimex so as to result in the distinct appearance of the claimed design including an extension of the contrasting look of the sides to the leg underside as shown in figure 4 of appellant's design.

Consequently, we agree with appellant that there is a significant difference in the overall visual impression of the claimed design over the appearance of the shorts of Metimex taken with Sportpages. On this record, the examiner has not established the prima facie obviousness of the claimed design based on the evidence relied upon.

CONCLUSION

The decision of the examiner to reject the appealed design claim under 35 U.S.C. § 103(a) as being unpatentable over Metimex in view of Sportpages is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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